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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,782	11/26/2003	John C. McKew	AM100831 P1	7235
25291	7590	02/14/2005	EXAMINER	
WYETH PATENT LAW GROUP 5 GIRALDA FARMS MADISON, NJ 07940			HABTE, KAHSA Y	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,782

Applicant(s)

MCKEW ET AL.

Examiner

Kahsay Habte, Ph. D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-14 are pending in this application.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3 (in part), drawn to AA = pyrimidinyl, classified in class 544, subclass 242.
 - II. Claims 1-3 (in part), drawn to AA = quinolinyl and isoquinolinyl, classified in class 546, subclass 139 and 152.
 - III. Claims 1-3 (in part), drawn to AA = pyridinyl, classified in class 546, subclass 314.
 - IV. Claims 1-3 (in part), drawn to AA = oxazolyl and isoxazolyl, classified in class 548, subclass 215 and 240.
 - V. Claims 1-3 (in part), drawn to AA = thioazolyl, classified in class 548, subclass 146 and 206.
 - VI. Claims 1-4 (in part) and 8-14, drawn to AA = indolyl, classified in class 548, subclass 469.
 - VII. Claims 1-3 (in part), drawn to AA = pyrrolyl and furyl, classified in class 548, subclass 530 and in class 549, subclass 429.
 - VIII. Claims 1-7 (in part), drawn to AA = phenyl, naphthyl and biphenyl (no heteroatom in the ring), classified in class 568, subclass various.

Art Unit: 1624

- IX. Claims 1-3 (in part), drawn to AA = alkenyl or alkynyl (no ring), classified in class various, subclass various.
- X. Claims 1-3 (in part), drawn to AA = others (Groups that don't fall into Groups I-IX), classified in class various, subclass various.

The inventions are distinct, each from the other because of the following reasons:

Groups I-X are directed to a process of making structurally dissimilar compounds such that the variable core created by the varying definitions of **AA** in the formula do not belong to the same recognized class of chemical compounds in the art, and references anticipating one invention, would not render obvious the others. For example, Group I is drawn to pyrimidines (2 nitrogens in a six-membered ring at 1,3-positions) that is not present in Groups II-X. Group II is different from Groups I and III-X, since it is drawn to quinolines and isoquinolines (bicyclic ring with one nitrogen). Group III is drawn to a six-membered ring with one nitrogen and is different from other groups. Group IV is drawn to oxazoles and isoxazoles (5-membered ring with one oxygen and one nitrogen) that is not present in the core structure of other groups. Group V is different from Groups I-IV and VI-X, since it is drawn to thiazoles (5-membered ring with one sulfur and one nitrogen). Group VI is also different from other groups, since it is drawn to indoles (5-membered ring with one nitrogen that is fused to a benzene ring). Group VII is different from Groups I-VI and Groups VII-X, since it is drawn to a 5-membered ring with one nitrogen or oxygen (monocyclic). Group VIII is drawn to phenyl, naphthyl and biphenyl (non-heterocyclic aryl ring) and is different from Groups I-VII, IX and X, since there is no

Art Unit: 1624

heteroatom in the ring. Group IX is drawn to alkenyl or alkynyl (no ring) and is different from other groups. Group X is drawn to others (e.g. AA = morpholiny, AA = pyridaziny, AA = cyclohexyl, etc.) and is different from Groups I-IX. Thus, separate searches in the literature as well as in the U.S. Patent Classification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds differ significantly in chemical structures. One skilled in the art would not consider such diverse structure equivalents of each other. If applicants elect Group VIII, IX or X; a tentative election of species is required.

Because these inventions are distinct for the reasons given above and have acquired separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Joseph Mazzaresse on Jan. 28, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

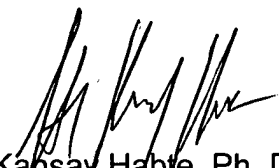
Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

Art Unit: 1624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on (571) 272-0674, if there is no reply within 24 hours, James Wilson (Acting SPE) can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kamsay Habte, Ph. D.
Examiner
Art Unit 1624

KH
February 10, 2005